

## REMARKS

### I. Rejection under 35 USC §102.

Claims 1-18 have been rejected under 35 USC §102(b) as being anticipated by Wheeler WO 97/32559. The rejection states as follows, in pertinent part:

Wheeler teaches cosmetic or pharmaceutical composition comprising a stable dispersion that comprises oil-based bi-liquid foam and an aqueous gel. The oil-based bi-liquid foam and an aqueous gel. The oil-based biliquid foam comprises from 1% to 80% by weight of the total formulation. The composition of Wheeler also comprises silicone oils....Wheeler teaches a formulation further comprising from 0.05% to 0.5% of surfactant and active ingredient in the aqueous or oily phase. Wheeler teaches that eh low level of surfactant incorporated into the formulation comprises quaternary ammonium sulfonium salt, amphoteric surfactant, anionic surfactant, alpha-olefin, alpha-olefin sulfonate, and ester-linked sulfonate. Salts of cross-linked polymers of acrylic acid(carbomers), glyceryl polymethacrylates, or copolymers of polyoxyethylene/polyoxypropylene in mixtures with the previously listed surfactants may serve as gelling agents. Wheeler's composition (example 3) comprises citric acid and the composition is adjusted to pH 6,5...Instant claims 1 and 12 are directed to a composition and gelling the composition with a polymeric sulfonic acid or poly(acryldimethyltauramide-covinylformamide) carries no patentable weight in a compositions claim because it is not critical how the composition is made in a composition claim...Instant claims 2, 6, 7, and 18 are directed to how the compositions of instant claims 1 and 12 are gelled and in a composition claim it is not critical how the composition is made. Regarding claims 9, 10, 14 and 15, a point in the amount of the oil-based bi-liquid foam of 1% to 80% of the total formulation in Wheeler anticipates a point in the amount of 50-90%. Regarding instant claims 11 and 17, the prior art teaches a surfactant in the amount of between about 0.05% and 0.5% and this amount is less that [sic]about 1% that [sic] is recited in said instant claims 11 and 17. Wheeler anticipates the claims.

Applicants respectfully traverse this rejection, in that the Examiner's analysis of the gellant and its patentable weight in the present claims is entirely incorrect. First, the statement that "it is not critical how the composition is made in a composition claim" is inaccurate. The method by which the composition is made can be critical in certain types of claims: the Examiner should be acquainted with "product-by-process" claims, in which the method by which the composition is made is in fact a critical aspect of the claim and is accorded patentable weight. See *Bonito Boats Inc. v. Thunder Craft Boats Inc.*, 489 U.S. 141 (1989). Since the Examiner has not provided any analysis on why a composition gelled by a polymeric sulfonic acid is no different from a composition gelled by a completely chemically distinct gellant, on this basis alone, the Examiner's rejection is flawed and cannot be sustained. Notwithstanding the foregoing, it is not necessarily Applicants' intention to claim the composition as a product by process, and so if it will assist the Examiner in seeing the error in the rejection, Applicants have

reworded claims 1 and 12 to refer simply to the aqueous phase as comprising a polymeric sulfonic acid gellant. Support for this amendment is found in the specification on page 4, lines 15-16, where it is clearly stated that the gellant is a component of the aqueous phase, and Example 1 illustrates a composition of the invention in which the aqueous phase of the composition comprises a polymeric sulfonic acid. There is therefore now no possible confusion about the claimed components of the composition or whether it is a method that is the distinguishing feature of the claim.

If the Examiner now reviews the claims in view of the components as claimed, it will be apparent that there is no anticipation of the claims as amended by Wheeler. Although the Examiner has extensively listed the gellants present in the Wheeler compositions, there has been no citation of the presence of a polymeric sulfonic acid gellant anywhere in Wheeler. It is therefore unclear to Applicants how the Wheeler compositions, in the utter absence of a polymeric sulfonic acid gellant of any kind, can be said to anticipate the present claims. It is well established that each and every element of the claimed invention must be found within a single prior art reference. *In re Paulsen*, 31 USPQ2d 1671 (Fed.Cir. 1994). The PTO has failed to bear its burden to show that every element of the present claims is contained in Wheeler, in that it has not shown anywhere in Wheeler the disclosure of a polymeric sulfonic acid. If it is the Examiner's position that the "mixtures" of polymeric gelling agents with sulfonate surfactants somehow creates or constitutes a polymeric sulfonic acid, this is simply chemical fantasy. Indeed, the Examiner even expressly states, in the subsequent obviousness rejection in the office action, that "Wheeler does not use polymeric sulfonic acid as a gelling agent" (page 4, lines 5-6), which clearly contradicts the Examiner's position in this anticipation rejection. Should the Examiner continue to maintain the position that Wheeler discloses each and every element of the present claims, Applicants respectfully request that the Examiner document where in Wheeler is disclosed a polymeric sulfonic acid gellant, and if it is the position the simple mixture of non-sulfonic acid polymers with sulfonate surfactants produces a polymeric sulfonic acid gellant, then this position, which would appear to be contrary to fundamental tenets of chemistry, must be supported by some technical evidence that this is so. However, in the absence of any showing that a polymeric sulfonic acid gellant is disclosed in Wheeler, the rejection must be withdrawn.

## II. Rejection under 35 USC §103

Claims 19-21 have been rejected under 35 USC §103(a) as being unpatentable over Wheeler in view of the Clariant product brochure. The rejection states:

Wheeler teaches the preparation of bi-liquid foam by combining oil-based biliquid foam and an aqueous gel, CARBOPOL gelling polymer and the pH is adjusted to 6.5 with citric acid... However, Wheeler does not use polymeric sulfonic acid as a gelling agent. However, Clariant product brochure teaches Aristoflex AVC or copolymer of polyacryldimethyltauramide and vinylformamide gelling agent for aqueous systems and thickening agent for oil-in-water emulsions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare the bi-liquid foam by gelling the composition with CARBOMER polymer according to the teachings of Wheeler. One having ordinary skill in the art would have been motivated to substitute CARBOMER gelling agent with another gelling agent such as polyacryldimethyltauramide-covinylformamide (Aristoflex) with the expectation that the aqueous composition will be gelled.

Applicants readily acknowledge that the polymeric sulfonic acids of the present invention are known in the art for use as a gellant of an aqueous phase of an emulsion. It is also acknowledged that carbomer is recommended for use as a gelling agent by Wheeler. The key piece of information that is not found in either of the documents is the unexpected superiority of the polymeric sulfonic acid in gelling the aqueous dispersion containing biliquid foam in comparison with CARBOMER. As Applicants have noted in the specification, the use of carbomers in gelling biliquid foam-containing aqueous dispersions is less than successful at low pH, and a stable dispersion is not obtained. Applicants have provided two previous declarations to that effect, demonstrating that at pH of less than 7, carbomers, as well as several of the other types of gellants recommended by Wheeler, do not provide a non-homogeneous, unstable product. In contrast, when a polymer sulfonic acid gellant is substituted in the same compositions, a smooth, homogeneous composition is obtained. Applicants herewith resubmit both previously submitted declarations (Matathia and Harrison) which unequivocally demonstrate the superiority of the polymeric sulfonic acid in stably gelling the biliquid foam dispersions at pHs below 7. This superiority is unexpected and not suggested by the references cited.

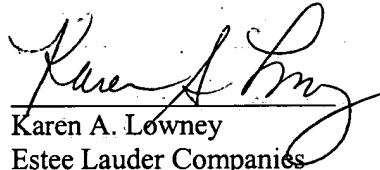
The Examiner cites Wheeler as teaching that the formulations can be adjusted to a pH of 6.5 (i.e., less than 7, as pertinent to the present claims) in the presence of carbomer. However, if the example from Wheeler cited for this proposition, it will be seen that the formulation as a whole has an enormous amount of surfactant (>50%) which of course will counteract any tendency to instability in the use of carbomers as the gellant. In contrast, in Example 4, where carbomer is again used, but in the absence of large amounts of surfactant, the pH is adjusted to 7. Therefore, again, the stability of the biliquid foam in an aqueous dispersion having a pH of less than 7, in the absence of large quantities of surfactants, would not be predicted. This is confirmed in the Harrison declaration previously submitted.

To the extent one skilled in the art may consider the substitution of one water soluble gellant of the other, on the assumption that all gellants of this type are equivalent, the data presented illustrate the non-equivalence of the Wheeler gellants and the polymeric sulfonic acid gellants, and the unexpected results, in terms of stability at a pH of less than 7, unequivocally rebut any *prima facie* case of obviousness that may be found in the combination of the Wheeler and Clariant references. Withdrawal of the rejection of claims 19 and 20 under 35 USC §103(a) is therefore respectfully requested.

#### CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,



Karen A. Lowney  
Estee Lauder Companies  
125 Pinelawn Road  
Melville, NY 11747  
(631)531-1191